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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,888

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23632 7590 04/24/2009  
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EXAMINER

HEINCER, LIAM J

ART UNIT

PAPER NUMBER

1796

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,888	<b>Applicant(s)</b> PETRUS ET AL.	
	<b>Examiner</b> Liam J. Heincer	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,10-17 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5 and 10-17 is/are allowed.
- 6) ☒ Claim(s) 21-23 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/30/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Saya et al. (EP 1036878) as evidenced by the original specification.

Considering Claim 21: Saya et al. teaches a method for liquefying paper/cellulose (¶0001) comprising heating lignocellulosic material (¶0039) to a temperature of of 100 to 200 °C (¶0037) in the presence of an acid catalyst \*¶0030) and valerolactone as a solvent (¶0033). Saya et al. also teaches the solvent as being present in an weight ratio with the lignocellulose of 0.5 to 3 (¶0030). As evidenced by the original specification, valerolactone can be obtained from levulinic acid (7:1-3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 1796

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saya et al. (EP 1036878) as evidenced by the original specification as applied to claim 1 above.

Considering Claim 22: Saya et al. teaches the process of claim 21 as shown above.

Saya et al. also teaches the solvent as being present in an weight ratio with the lignocellulose of 0.5 to 3 (¶0030). This ratio overlaps with the claimed ratio of 3 to 20. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). It would have been obvious to a person having ordinary skill in the art at the time of invention to have used the high end of the disclosed range, and the motivation to do so would have been to fully dissolve the lingocellulosic material.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saya et al. (EP 1036878) as evidenced by the original specification.

Considering Claim 23: Saya et al. teaches a method for liquefying paper/cellulose (¶0001) comprising heating lignocellulosic material (¶0039) to a temperature of of 100 to 200 °C (¶0037) in the presence of an acid catalyst \*¶0030) and valerolactone as a solvent (¶0033). Saya et al. also teaches the solvent as being present in an weight ratio with the lignocellulose of 0.5 to 3 (¶0030). As evidenced by the original specification, valerolactone can be obtained from levulinic acid (7:1-3).

Saya et al. also teaches the solvent as being present in an weight ratio with the lignocellulose of 0.5 to 3 (¶0030). This ratio overlaps with the claimed ratio of 3 to 20. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). It would have been obvious to a person having ordinary skill in the art at the time of

invention to have used the high end of the disclosed range, and the motivation to do so would have been to fully dissolve the lingocellulosic material.

### ***Double Patenting***

Claims 24-26 objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1, 16, and 13 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21 and 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 11/420,981. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 6 of application '981 teaches teaches a process of heating lignocellulosic material in a species of the claimed lactone (Claim 14) and an acid (Claim 6) as a solvent at a temperature in the range of 50 to 210 °C (Claim 14).

Claim 6 of application '981 does not teach the claimed amounts of solvent and catalyst. However, differences in concentration generally will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. It would have been obvious to a person having ordinary skill in the art at the time of invention to have optimized the amount of catalyst and solvent in the process of Claim 6 of application '981 through routine experimentation, and the motivation to do so would have been to ensure a full breakdown of the lignocellulosic material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 23 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 11/420,981. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 6 of application '981 teaches teaches a process of heating lignocellulosic material in a species of the claimed lactone (Claim 14) and an acid (Claim 6) as a solvent at a temperature in the range of 50 to 210 °C (Claim 14).

Claim 6 of application '981 does not teach the claimed amounts of solvent and catalyst. However, differences in concentration generally will not support the patentability of subject matter encompassed by the prior art unless there is evidence

Art Unit: 1796

indicating such concentration is critical. See MPEP § 2144.05. It would have been obvious to a person having ordinary skill in the art at the time of invention to have optimized the amount of catalyst and solvent in the process of Claim 6 of application '981 through routine experimentation, and the motivation to do so would have been to ensure a full breakdown of the lignocellulosic material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Allowable Subject Matter***

Claims 1, 5, and 10-17 are allowed.

The following is an examiner's statement of reasons for allowance: The instant claims require the use of a solvent of specific structure in a liquefaction process for lignocellulosic or cellulosic material. There is nothing in the prior art of record to teach or suggest these solvents in the claimed process. The closest prior art, Saya et al. (EP 1036878), teaches a lactone solvent for a liquefaction process (§0033). However, the reference does not suggest attaching an acid or ester group of the claimed structure at the gamma position of the lactone.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The claims of the instant application are still considered to not be patentably distinct from those of application 11/420,981. However, as the instant application has an earlier filing date, and claims 1, 5, and 10-17 are otherwise allowable, the double patenting rejection on these claims is dropped. See MPEP § 804(I)(B).

### ***Response to Arguments***

Applicant's arguments filed January 30, 2009 with respect to claims 21-23 have been fully considered but they are not persuasive, because:

A) Applicants argument that Saya et al. does not teach the lactone as being obtainable from levulinic acid is not persuasive. If the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP § 2112.01. As the reference teaches the use of valerolactone (¶0033), which the original specification states can be obtained from levulinic acid (7:1-3), the limitation “obtainable from levulinic acid” is inherently met.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/

LJH

Supervisory Patent Examiner, Art Unit 1796

April 17, 2009